

that amended claims 1 and 7 distinguish the invention over the prior art and particularly over the art relied on by the Examiner in rejecting the claims of the instant application. In addition, applicant has added claims 10-18. New independent claims 10, 13, 14, 17, and 18 distinguish over the prior art and particularly over the teachings and implications of Saitoh for reasons discussed below.

**The Invention** Applicant's invention, as described in the specification, is directed to a novelty item in the form of a sea shell with devices for reproducing a predetermined sound different from what one would normally hear upon placing of a sea shell next to his or her ear. When placing a sea shell such as a conch shell next to an ear, people expect to hear a sound approximating that of the ocean, more specifically, that of the surf near a beach. Hearing something different is surprising and entertaining.

**Claim 1** As set forth in amended claim 1, a novelty or entertainment device comprises, in accordance with the present invention, a housing in the form of a sea shell, a sound reproduction system mounted to the housing so as to remain hidden from casual visual inspection of the housing, and a switch mounted to the housing and operatively connected to the sound reproduction system for activating same after and only after a lifting of the housing to an ear of a user.

Nothing in the prior art relied on by the Examiner teaches or suggests a switch connected to a sound reproduction system in a housing for activating that system after and only after the housing is lifted to an ear of a user. This feature of the invention is especially useful for the carrying out novelty purpose of the present invention. Hearing the sound of the ocean occurs

only when a sea shell has been placed next to the ear of the user. The novelty of the present invention would be considerably diminished if a sound were heard prior to the usual time when the expected ocean sound is perceivable.

Saitoh discloses an animated toy bird which has an external stimulus sensor in the form of a pyroelectric sensor for detecting infrared rays radiated from a human body. “[W]hen a person goes past or approaches the toy bird, the pyroelectric sensor detects infrared rays emitted from him to cause the control circuit 45 to actuate the motor 29 and sound generating unit 43 for a predetermined period of time....” (Col. 4, lines 32-36.) Clearly, Saitoh teaches the activation of the sound generating unit prior to any manual engagement of the toy bird. The switch and control circuit of Saitoh are thus contrary to the invention as set forth in amended claim 1.

**Claim 7** As recited in amended claim 7, a novelty or entertainment method pursuant to the present invention comprises providing a housing in the form of a sea shell and, in response to a removal of the housing from a stationary storage position towards an ear of a user, reproducing a predetermined sound so that the reproduced sound may be perceived by the user upon and only upon an approximation of a mouth of the housing to the ear of the user.

It would interfere with the novelty of applicant’s method if a sound were to emanate from the sea shell prior to a proper approximation of the sea shell to the ear of the user. Saitoh does not teach or suggest the reproduction of sound so as to be perceived by the user upon and only upon an approximation of a mouth of a housing to the ear of the user. Instead, Saitoh teaches the generation of sound upon a mere approach of a user to a toy bird. Thus, if the user were to lift the toy bird, the sound reproduction would be commenced even before the hand of the user could

contact the toy.

**Claim 10** A novelty or entertainment device comprises, in accordance with claim 10, a housing in the form of a sea shell, a sound reproduction system mounted to the housing so as to remain hidden from casual visual inspection of the housing, and a switch mounted to the housing and operatively connected to the sound reproduction system for activating same in response to a lifting of the housing to an ear of a user, the switch including means for selectively activating the sound reproduction system only after the housing has been placed proximate to the ear of the user.

Saitoh neither discloses nor suggests a switch including means for selectively activating the sound reproduction system only after the housing has been placed proximate to the ear of the user. Saitoh only teaches that a sound reproduction device is to be activated where a person is nearby.

**Claim 13** A novelty or entertainment device comprises, in accordance with new independent claim 13, a housing in the form of a sea shell, a sound reproduction system mounted to the housing so as to remain hidden from casual visual inspection of the housing, and a switch mounted to the housing and operatively connected to the sound reproduction system for activating same in response to a lifting of the housing to an ear of a user. As recited in claim 13,

sound of a real bird. Saitoh says nothing about having different bird sounds emanate from the same toy bird. In fact, Saitoh teaches that different sounds may be employed in *different* kinds of toy birds, so that the song or twitter of any one toy matches the kind of bird simulated by that toy. Moreover, Saitoh says nothing about reproducing different stored sounds on successive activations of a sound reproduction system.

**Claim 14** Asset forth in new independent claim 14, a novelty or entertainment method comprises providing a housing in the form of a sea shell and after and only after a removal of the housing from a stationary storage position towards an ear of a user, reproducing a predetermined sound so that the reproduced sound may be perceived by the user.

In its normal use, the toy bird of Saitoh is not intended to be picked up, let alone placed near the ear of a user. Since the bird toy moves, it might even be dangerous to one ear to place the toy near an ear or an eye. The sound reproduction in the toy bird of Saitoh occurs while the toy is sitting still. The movement and the sound reproduction are triggered by the mere approach of a warm body (radiating infrared electromagnetic energy). Nothing in Saitoh teaches or suggests reproducing a predetermined sound after and only after a removal of the toy bird from a stationary storage position towards an ear of a user.

**Claim 17** As recited in new independent claim 17, a novelty or entertainment method comprises providing a housing in the form of a sea shell and, in response to a first removal of the housing from a stationary storage position towards an ear of a user, reproducing a first predetermined sound so that the reproduced sound may be perceived by the user. The method of

storage position towards an ear of a user, reproducing a second predetermined sound so that the reproduced second predetermined sound may be perceived by the user, the second predetermined sound being substantially different from the first predetermined sound.

Saitoh says nothing about varying the sound reproduced in his toy bird, except that toy birds of different types (e.g., different bird species) may have songs or twitters appropriate to their types. One type of toy bird thus plays a single simulated song appropriate to that bird only.

**Claim 18** A novelty or entertainment device comprises, pursuant to new independent claim 18, a housing in the form of a sea shell and a sound reproduction system mounted to the housing so as to remain hidden from casual visual inspection of the housing. The sound reproduction system includes a memory storing a signal corresponding to a predetermined sound substantially different from sound generated in nature upon placement of a sea shell next to an ear. A switch mounted to the housing is operatively connected to the sound reproduction system for activating same in response to a lifting of the housing to an ear of a user.

Saitoh teaches that the sound to be reproduced matches or simulates the natural sound of the bird species on which the toy bird is modeled. One of ordinary skill in the art following the teachings of Saitoh, if induced in some way not available from the art of record, to place a sound reproduction system in a real or artificial sea shell, would have the sound reproduction system imitate the natural sound of a sea shell. Nothing in Saitoh suggests storing and reproducing a predetermined sound substantially different from sound generated in nature upon placement of a sea shell next to an ear.

It is to be noted that various claims of the instant application contemplate the control of

sound reproduction to commence at a time when a user might expect to hear an ocean sound. It is to be understood, however, that this control need not be exercised on *every* lifting of the sea shell. For instance, where a sea shell is raised shortly after a sound activation, the new sound reproduction may be actuated earlier, for instance, upon a touching of the shell (even before a lifting thereof), in order to enhance the surprise and entertainment value of the novelty item.

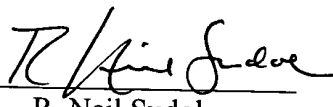
***Conclusion***

For the foregoing reasons, independent claim 1, as well as the claims dependent therefrom, is deemed to be in condition for allowance. An early Notice to that effect is earnestly solicited.

Should the Examiner believe that direct contact with applicant's attorney would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the number below.

Respectfully submitted,

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Dated: August 9, 2001

**APPENDIX TO AMENDMENT IN APPLICATION NO. 09/661,520  
SHOWING MARKED UP VERSIONS OF AMENDED CLAIMS**

1. (Once Amended) A novelty or entertainment device comprising:  
a housing in the form of a sea shell;  
a sound reproduction system mounted to said housing so as to remain hidden from casual visual inspection of said housing; and  
a switch mounted to said housing and operatively connected to said sound reproduction system for activating same [in response to] after and only after a lifting of said housing to an ear of a user.

Amend claim 7 as follows:

7. (Once Amended) A novelty or entertainment method comprising:  
providing a housing in the form of a sea shell; and  
in response to a removal of said housing from a stationary storage position towards an ear of a user, reproducing a predetermined sound so that the reproduced sound may be perceived by the user upon and only upon an approximation of a mouth of said housing to the ear of the user.